



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097086,327	05/28/98	DURETTE	P 19965Y

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HM11/1216

EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1654

DATE MAILED:

12/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/086327

Applicant(s) Durette

Examiner D. Lukton

Group Art Unit 1654

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 0 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. (30 days)

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/4/98
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☒ Claim(s) 1-20 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

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Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-4, drawn to a method of treatment in which Y is one of the following, classified in, e.g., 540/001:



II. Claims 1-4, drawn to a method of treatment in which Y is $-\text{CO}-$ or $-\text{OCO}$ or $-\text{N}(\text{R}^e)-\text{CO}-$, and none of R^3 , R^4 or R^5 may form a ring, classified in, e.g., 540/001.

III. Claims 1-4, drawn to a method of treatment in which Y is CO or $-\text{OCO}$ or $-\text{N}(\text{R}^e)-\text{CO}-$, and at least one of R^3 , R^4 and R^5 is part of a ring, classified in, e.g., 540/001.

IV. Claims 5-17 and 20, drawn to compounds, classified in, e.g., 514/19.

V. Claims 18-19, drawn to methods of using Group IV compounds, classified in, e.g., 514/19.

The claimed inventions are distinct.

Claims 1-4 have been sequestered into 3 groups. Claim 1 limits the recited compounds to those that have an effect on a cell adhesion process. However, in applying prior art, it is not necessarily the case that the reference which teaches the compound in question make any reference to a cell adhesion phenomenon. If a connection can be made, however indirectly, to some event or process that is somehow connected to an integrin, or to some other cell adhesion-mediated phenomenon, then the reference at issue would render

claim 1 obvious, if not anticipated. Given the pervasive nature of cell adhesion phenomena in mammalian systems, the recited method is not as limiting as it might first appear. In the event that one of Groups I-III is elected, however, the possibility of rejoining one or more of the other groups is not precluded, especially if all of the compounds within the elected group turn out to be novel.

Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the compounds may be asserted to interact with one or more receptors. However, pursuant to *In re Ochiai* (37 USPQ2d 1127), in the event that applicants and claims therein are found allowable, one or more claims drawn to a method of use will be rejoined for allowance, or further examination.

*

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie", in this case, is a specific compound. In addition, if a method of use claim is selected, a further election would be that of a specific disorder.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this

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requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

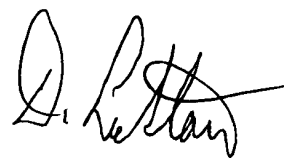
Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

A telephone call was made to Mollie Yang on 11/16/98 to request an oral election to the above restriction requirement, whereupon the restriction requirement was requested in writing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton [phone number (703)308-3213].

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800